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TECHNOLOGY CENTER 2100

In re Application of: Amirisetty, et al.)
Application No. 10/051,441) DECISION ON PETITION FOR
Attorney Docket No. 5181-92801) SUPERVISORY REVIEW REGARDING
Filed: 01/18/2002) FINALITY OF RESTRICTION
For: METADATA-AWARE ENTERPRISE) REQUIREMENT UNDER 37 CFR
APPLICATION INTEGRATION) §1.144
FRAMEWORK FOR APPLICATION	
SERVER ENVIRONMENT	

This is in response to the petition filed on November 16, 2005, under 37 CFR 1.144 requesting supervisory review of the finality of a restriction requirement mailed on September 20, 2005. Note, a petition under 37 CFR §1.144 will not be considered if reconsideration of the requirement was not previously requested.

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) A restriction requirement was mailed on June 27, 2005, in which claims 1-88 were subject to restriction requirement.
- (2) On July 15, 2005 a response to the restriction requirement was filed in which applicant provisionally elected with traverse. Applicant provided reasons in support of the traversal, including a discussion of M.P.E.P. § 806.05(d) regarding a proper restriction for inventions disclosed as subcombinations usable together in a single combination.
- (3) On September 20, 2005, the Examiner issued a first office action on the merits, in response to Applicant's election, wherein claims 36-50 and 62-72 were withdrawn. This office action determined the requirement for restriction to be proper and therefore effectively made the requirement FINAL.
- (4) On November 16, 2005, the instant petition was filed by Petitioner, under 37 CFR §1.144.

RELIEF REQUESTED

The instant petition under 37 CFR § 1.144 requests the following relief:

- (1) withdrawal of the restriction requirement of June 27, 2004; and
- (2) as a result of item (1), examination of all pending claims.

BASIS

Petitioner provides various arguments in support of the withdrawal of the restriction requirement including reference to M.P.E.P. § 806.05(d), which states:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually ****>restrictable** when the subcombinations do not overlap in scope and are not obvious variants<.

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

****** If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

In addition, note M.P.E.P. § 806.03 sets forth:

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

OPINION

Petitioner states that inventions Group I (claims 1-35, 51-61 and 73-88) and Group II (claims 36-50 and 62-72) are not disclosed as subcombinations usable together in a single combination, as stated. Applicant admits that the claims 1, 18, 51 and 73 vary in scope from claims 36 and 62, however, the disclosure clearly does not describe the embodiments of claims 36 and 62 as separate subcombinations (from that of claims 1-35, 51-61 and 73-88) being usable together in a single combination. In fact, the independent claims recite similar inventions not separate subcombinations, and cannot be characterized as such. For example, the embodiment of method claim 18 (Group I) can be carried out in the embodiment of the system of claim 36 (Group II).

Further, since MPEP 806.05(d) requires that the subcombinations “do not overlap in scope”. As identified by Applicant above, there is clearly overlap in scope between the claims of Group I and Group II. Overlap in scope is evident by way of comparison of claim 36 (Group II) with that of claim 51 (Group I) wherein both claims recite similar systems.

Thus, and in accordance with M.P.E.P. §806.03 and §806.05(d), the restriction requirement of June 27, 2005 between Group I (claims 1-35, 51-61 and 73-88) and Group II (claims 36-50 and 62-72), for “subcombinations usable together in a single combination” is deemed to be improper.

The petition is **GRANTED**. The previous action and election requirement is **WITHDRAWN** and a new office action on the pending claims will be forthcoming.

The application is being forwarded to the Examiner for appropriate action i.e. prosecution of all pending claims, consistent with this decision.

Any inquiries related to this decision may be directed to the undersigned at (571) 272-3595.



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